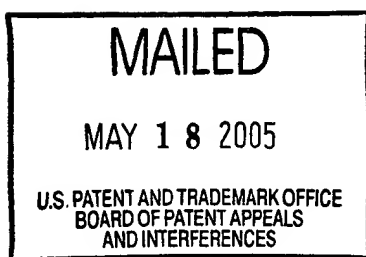


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte LAURENCE LEE,
FRANK WYATT, HEATHER GANSKE
and EUGENE H. SANDER

Application 09/917,433

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on April 28, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

On August 9, 2004, an Examiner's Answer was mailed. On page 3, section (10) of the Answer, the examiner states: "Claims 1-18,¹ [and] 26-30 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office action, mailed on June 12, 2002 and on November 6, 2003." The Manual of Patent Examining Procedure (MPEP) § 1208(A) (Eighth Edition, Rev. 2, May 2004) states:

Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection appearing in a *single* prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action.

Furthermore, MPEP § 706.07 states:

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

¹It should be noted that claims 1-12 were cancelled pursuant to the Preliminary Amendment filed July 27, 2001. Correction is required.

An examination of the application reveals that the examiner refers to more than one single Office action when stating the grounds of rejection. Therefore, the Examiner's Answer does not comply with the requirements set forth in MPEP §§ 706.07 and 1208(A). It should also be noted that according to the examiner on page 2 of the Answer, "[c]laim 19 has been cancelled according to Applicant's [sic] request submitted with the Appeal Brief." However, the first rejection appearing on page 3 of the Answer states that "[c]laims 13-16, 18, 19, [and] 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glatt et al. . . ." Confusion exists over the status of claim 19. Correction is required.

In addition, according to the Patent Application Location Monitoring (PALM) database, on April 25, 2003 a Notice of Withdrawn Action was mailed. We were unable to locate a copy of this paper in the Image File Wrapper (IFW).

Finally, an examination of the file reveals that an Information Disclosure Statement (IDS) was filed on January 16, 2002. It is not apparent from the record whether the examiner considered the statements submitted or notified appellants of why

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their submissions did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying appellants of the Primary Examiner's decision is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

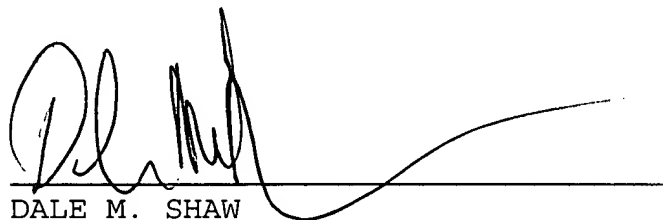
1. for submission of a Supplemental Examiner's Answer which complies with §§ 706.07 and 1208(A) of the MPEP concerning the grounds of rejection;
2. for clarification regarding the claims involved in the rejections;
3. for locating a copy of the Notice of Withdrawn Action mailed April 25, 2003 and having a complete copy scanned into the IFW file;
4. for consideration of the IDS filed January 16, 2002;
5. for proper notification to appellants regarding the above matters; and

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6. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:

A handwritten signature in black ink, appearing to read 'D. M. Shaw', is written over a horizontal line.

DALE M. SHAW
Program and Resource Administrator
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DMS/psb

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